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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,349	08/14/2001	Joong-Hyun Mun	06192.0263.NPUS00	6679

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EXAMINER

NGO, HUYEN LE

ART UNIT	PAPER NUMBER
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2871

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary	Application No. 09/928,349	Applicant(s) MUN ET AL.	
	Examiner Julie-Huyen L. Ngo	Art Unit 2871	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-50 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 12-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-11 and 39-50 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed December 20, 2004 have been fully considered but they are not persuasive.

Applicant's only arguments:

1) "*double patenting may exist between a single issued patent and an application filed by the same inventive entity having a common assignee.*" However, "*double patenting cannot exist between an application and a combination of multiple references, of which the inventive entities are different from the inventive entity of the application.*"

2) Requirement for Restriction be partially withdrawn and claims 9-11 and 39-50 be examined together as they read on the same INVENTION II.

Examiner's responses:

1) According to MPEP § 804, if there is a common assignee or inventor between the application and patent a double patenting rejection must be made.

Applicant is to note that there is a common assignee and an inventor exists between this pending application and the patent issued to Jang-Kun Song (US 6678031). Therefore, it is appropriate to apply double patenting between this pending application and Song patent since this application and Song patent have a common assignee, i.e, Samsung Electronics, and a common inventor, i.e., Jang-Kun Song.

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Further more, U. S. Patent No. 6,567,144 issued to Kim, and U. S. Patent No. 6,067,144 issued to Murouchi were provided and applied individually to each claim as evidences for showing that it is well known and conventional in the LC art to form:

a) A common electrode of ITO or IZO for having transparency with high conductivity, as taught by Kim (claim 11).

b) Protrusions/spacers of different heights on an electrode of a substrate for having a rigid liquid crystal display cell with superior productivity and durability, as taught by Murouchi (claim 49).

However these features are fully disclosed by Song; Therefore, Song alone would have met all the limitations recited in these claims of the pending application. Therefor, the double patenting rejection is appropriate and can be apply to this application as follow.

2) With respect to claims 39-46, these claims are no longer withdrawn and are examined together with claims 9-11, and 47-50 since they read on the same invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9-11 and 39-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 17-21 and 26 of U.S. Patent No. 6,678,031 B2 in view of Kim et al. (US 6567144 B1), and Murouchi (US 6067144 A).

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming common subject matters except for:

Claims 11 and 46, the common electrode formed of indium tin oxide (ITO) or indium zinc oxide (IZO);

Claim 45, the second end of the fourth protrusion is in contact with the liquid crystal material.

Claim 49, the third and forth protrusions formed on the common electrode.

Applicant is to note that any features that are not recited in a claim, but disclosed in the disclosure; it is indicated that the features are not critical and essential to the invention.

Song fully discloses in his granted patent that:

Claims 11 and 46, the common electrode is formed of ITO or IZO (see bridging paragraph of cols. 4 & 5);

Claim 45, the second end of the fourth protrusion is in contact with the liquid crystal material (See figure 11).

Claim 49, the third and forth protrusions 116/117 are formed on the common electrode 114 (see fig. 11).

However, with respect to claims 11 and 46, it is well known and conventional in the LC art for a common electrode be formed of ITO or IZO for having transparency with high conductivity, as evidenced by Kim with an ITO common electrode 13 formed over the color filter 12 having black matrix 11 formed within.

Therefore, it would have been obvious for one having ordinary skill in the art to have the common electrode be formed of ITO or IZO for having transparency with high conductivity, as taught by Kim.

With respect to claim 49, it is well known and conventional in the art to have protrusions/spacers of different heights formed on a electrode of a substrate for having a rigid liquid crystal display cell with superior productivity and durability, as evidenced by Murouchi (figure 4).

Therefore, it would have been obvious for one having ordinary skill in the art to have the third and forth protrusions formed on the common electrode for having a rigid liquid crystal display cell with superior productivity and durability, as evidenced by Murouchi.

The limitations of claims 9-11 and 39-50 are fully meet by Song, or by Song in view of Kim (claims 11 and 46) or Song in view of Murouchi (claim 49).

Conclusion

This application contains claims 8 and 12-38 drawn to an invention nonelected with traverse in letter filed on October 08, 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Julie-Huyen L. Ngo whose telephone number is (571) 272-2295. The Examiner can normally be reached on T-Friday.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Robert H. Kim can be reached at (571) 272-2293.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.

March 12, 2005



Julie-Huyen L. Ngo
Primary Examiner
Art Unit 2871